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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/534,500

05/10/2005

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Q87811

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23373 7590 10/31/2008
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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

10/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---|--------------------------------------|--|
| Office Action Summary | Application No. 10/534,500 | Applicant(s) OHASHI ET AL. | |
| | Examiner Katarzyna Wyrozebski | Art Unit 1796 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

In view of applicant's response dated 7/21/2008 following office action is final as necessitated by amendment. Applicant's amendment incorporated into claim 1 limitation of claim 5, which limitation was previously not required to reject claims 2-4, 8, 9, 11-13, 17 of the instant invention. Several claims were previously dependent on claim 5, since the dependency of the claims changed to claim 1, the claims will be re-evaluated for rejections.

Double Patenting

Applicant's amendment did not overcome Double Patenting rejection, since limitation of the oil is found in claim 8 of the co-pending invention.

Submission of the certified translation of the priority document overcame the rejections over the prior art of NAKAGAWA, HENNING and WEYDERT.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 1796

2. Claims 1-4, 6-13, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over IMAI (US 4,360,049) in view of RALWINSON (US 2002/0198296).

The discussion of the disclosure of the prior art of IMAI from paragraph 4 of the office action dated 3/19/08 is incorporated here by reference.

The difference between the teachings of IMAI and the instant invention lies in newly added limitation to the independent claims, which limitation includes hydrogenated naphtheneic oil in the composition.

With respect to the above disclosure RAWLINSON discloses rubber composition for use in tire tread. Specifically applicant's attention is drawn to paragraphs [0024-0025], which recites hydrogenated naphtheneic oils having DMSO extraction of less than 3 wt %.

According to RALWINSON, addition of oils to such compositions improves wet skid behavior as compared to the rubbers which do not have such oil.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil in the composition of IMAI and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance.

3. Claims 1-4, 6-13, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over IMAI (US 4,360,049) in view of SOHEN (US 2002/0045697)

Art Unit: 1796

The discussion of the disclosure of the prior art of IMAI from paragraph 4 of the office action dated 3/19/08 is incorporated here by reference.

The difference between the teachings of IMAI and the instant invention lies in newly added limitation to the independent claims, which limitation includes hydrogenated naphtheic oil in the composition.

With respect to the above disclosure SOHEN discloses rubber composition for use in tire tread. Specifically applicant's attention is drawn to paragraph [0025], which recites hydrogenated naphthenic oils having DMSO extraction of less than 3 wt %.

According to SOHEN, addition of oils to such compositions improves wet skid behavior as compared to the rubbers which do not have such oil.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil in the composition of IMAI and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance.

4. Claims 1, 2, 4, 6-8, 10-13, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over HASHIMOTO (EP 939,104) in view of RALWINSON (US 2002/0198296) and evidence provided in IMAI (US 4,360,049).

The discussion of the disclosure of the prior art of HASHIMOTO from paragraph 5 of the office action dated 3/19/08 is incorporated here by reference.

Art Unit: 1796

The difference between the teachings of HASHIMOTO and the instant invention lies in newly added limitation to the independent claims, which limitation includes hydrogenated naphtheic oil in the composition.

With respect to the above disclosure RAWLINSON discloses rubber composition for use in tire tread. Specifically applicant's attention is drawn to paragraphs [0024-0025], which recites hydrogenated naphthenic oils having DMSO extraction of less than 3 wt %.

According to RALWINSON, addition of oils to such compositions improves wet skid behavior as compared to the rubbers which do not have such oil.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil in the composition of HASHIMOTO and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance.

5. Claims 1, 2, 4, 6-8, 10-13, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over HASHIMOTO (EP 939,104) in view of SOHEN (US 2002/0045697) and evidence provided in IMAI (US 4,360,049).

The discussion of the disclosure of the prior art of HASHIMOTO from paragraph 5 of the office action dated 3/19/08 is incorporated here by reference.

The difference between the teachings of HASHIMOTO and the instant invention lies in newly added limitation to the independent claims, which limitation includes hydrogenated naphtheic oil in the composition.

Art Unit: 1796

With respect to the above disclosure SOHEN discloses rubber composition for use in tire tread. Specifically applicant's attention is drawn to paragraph [0025], which recites hydrogenated naphthenic oils having DMSO extraction of less than 3 wt %.

According to SOHEN, addition of oils to such compositions improves wet skid behavior as compared to the rubbers which do not have such oil.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil in the composition of HASHIMOTO and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance.

6. Claims 1, 2, 4, 6-8, 10, 11, 13, 15, 16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over RUSSELL (GB 2,239,870) in view of RAWLINSON (US 2002/0198296) and evidence provided in IMAI (US 4,360,049).

The discussion of the disclosure of the prior art of RUSSELL from paragraph 7 of the office action dated 3/19/08 is incorporated here by reference.

The difference between the teachings of RUSSELL and the instant invention lies in newly added limitation to the independent claims, which limitation includes hydrogenated naphthenic oil in the composition.

With respect to the above disclosure RAWLINSON discloses rubber composition for use in tire tread. Specifically applicant's attention is drawn to paragraphs [0024-0025], which recites hydrogenated naphthenic oils having DMSO extraction of less than 3 wt %.

Art Unit: 1796

According to RALWINSON, addition of oils to such compositions improves wet skid behavior as compared to the rubbers which do not have such oil.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil in the composition of RUSSELL and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance.

7. Claims 1, 2, 4, 6-8, 10, 11, 13, 15, 16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over RUSSELL (GB 2,239,870) in view of SOHEN (US 2002/0045697) and evidence provided in IMAI (US 4,360,049).

The discussion of the disclosure of the prior art of RUSSELL from paragraph 7 of the office action dated 3/19/08 is incorporated here by reference.

The difference between the teachings of RUSSELL and the instant invention lies in newly added limitation to the independent claims, which limitation includes hydrogenated naphtheneic oil in the composition.

With respect to the above disclosure SOHEN discloses rubber composition for use in tire tread. Specifically applicant's attention is drawn to paragraph [0025], which recites hydrogenated naphtheneic oils having DMSO extraction of less than 3 wt %.

According to SOHEN, addition of oils to such compositions improves wet skid behavior as compared to the rubbers which do not have such oil.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil in the composition of

Art Unit: 1796

RUSSELL and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance.

8. Claims 1-4, 6-13, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAKAYAMA (US 4,840,988) in view of RALWINSON (US 2002/0198296) and evidence provided in IMAI (US 4,360,049).

The discussion of the disclosure of the prior art of NAKAYAMA from paragraph 8 of the office action dated 3/19/08 is incorporated here by reference.

The difference between the teachings of NAKAYAMA and the instant invention lies in newly added limitation to the independent claims, which limitation includes hydrogenated naphtheic oil in the composition.

With respect to the above disclosure RAWLINSON discloses rubber composition for use in tire tread. Specifically applicant's attention is drawn to paragraphs [0024-0025], which recites hydrogenated naphthenic oils having DMSO extraction of less than 3 wt %.

According to RALWINSON, addition of oils to such compositions improves wet skid behavior as compared to the rubbers which do not have such oil.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil in the composition of NAKAYAMA and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance.

Art Unit: 1796

9. Claims 1-4, 6-13, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAKAYAMA (US 4,840,988) in view of SOHEN (US 2002/0045697) and evidence provided in IMAI (US 4,360,049).

The discussion of the disclosure of the prior art of NAKAYAMA from paragraph 8 of the office action dated 3/19/08 is incorporated here by reference.

The difference between the teachings of NAKAYAMA and the instant invention lies in newly added limitation to the independent claims, which limitation includes hydrogenated naphtheic oil in the composition.

With respect to the above disclosure SOHEN discloses rubber composition for use in tire tread. Specifically applicant's attention is drawn to paragraph [0025], which recites hydrogenated naphthenic oils having DMSO extraction of less than 3 wt %.

According to SOHEN, addition of oils to such compositions improves wet skid behavior as compared to the rubbers which do not have such oil.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil in the composition of NAKAYAMA and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance.

In view of applicant's amendment incorporating hydrogenated oil into claim 1, the rejections of record have been re-addressed to ensure that all limitation of claim 1 are addressed.

Applicant's arguments are now considered moot, since the amendment required new grounds of rejections.

Art Unit: 1796

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 8:30 AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Katarzyna Wyrozebski/
Primary Examiner, Art Unit 1796
October 28, 2008